IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ake SJOBERG | Confirmation: 1992

Serial No.: 10/580,255 | Group Art Unit: 1791

Filed: June 7, 2006 | Examiner: MUSSER, BARBARA J

For: **A PROCESS FOR THE MANUFACTURING OF A DECORATIVE SURFACE ELEMENTS WITH A SURFACE STRUCTURE**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejections prior to filing a brief in this matter.

THE INVENTION

The invention as defined by independent claim 1 (and claims 2-16 dependent thereon) is directed to a process for the manufacturing of a decorative surface element with surface structure. The element comprises a core material comprising particleboard or fiberboard; a decorative surface layer and a protective upper wear layer. At least one of the decorative surface layer and wear layer comprises a thermosetting resin. The process comprises the steps of providing an upper surface of the core material with a surface structure; applying a decorative surface layer on top of the surface structure core; applying a protective wear layer on the decorative surface layer; and, pressing the core material, the decorative layer and wear layer "under increased pressure and temperature in a laminate press so that resin cures and the different layers are bonded to one another".

Claims 1-6 and 11-16, stand rejected under 35 U.S.C. 103 (a) as being unpatetnable over Chen et al (U.S. Publication 2004/0086678A1) in view of Chen et al. (U.S. Patent 6, 617, 009).

Claims 7-10 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Chen et al. '678 as applied to claim 1 above and further in view of Chen et al. '009.

Claim 13 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Chen et al. '678 as applied to claim 1 above and further in view of the admitted prior art.

None of these rejections are sustainable by the Board of Appeals for the following reasons.

THE REJECTION OF CLAIMS 1-6 AND 11-16

Under *KSR* the Examiner acts as a fact finder in locating references that teach the claimed limitations.

Here, the Examiner admits that Chen et al., '678 "does not disclose pressing the layers together under increased pressure and temperature to bond them together and cure the thermosetting resin". Although the Examiner has cited the Chen et al., '009 Patent in the statement of the rejection, the Examiner does not rely on Chen et al., '009 in the body of the rejection, nor is there any allegation that Chen et al., '009 cures the admitted deficiency in Chen et al '678 as not disclosing pressing the layers together under increased pressure and temperature to bond them together and cure the thermosetting resin.

Therefore, while the Examiner states "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a platen press with increased pressure and temperature to cure the wear layer while embossing it since the reference Chen et al., '678 "discloses using increased pressure and temperature in a press to apply a texture and that texture can be applied to the wear layer" there is no evidence in the record supporting the Examiner's conclusionary statement of obviousness. The Examiner cites to no evidence to cure the admitted deficiency in the Chen et al., '678 teaching and thus, mere conclusionary statements do not establish a prima facie case of obviousness in the absent of evidence under *KSR*.

THE REJECTIONS OF DEPENDENT CLAIMS 2, 4-6, 11, 13 AND 14

Regarding the specific rejections of dependent claims 2, 4-6, 11, 13 and 14, the Examiner further admits that "the reference (Chen et al., '678) does not disclose these specific methods of applying texture, they appear to be well-known in conventional methods as applicant has not

described them in any detail, indicating that those in the art know how to use the devices to perform the desired task".

Applicants dispute the Examiner's self-serving statement.

Attention is directed to the paragraph beginning at line 5 of page 5, extending to the penultimate line on page 5, describing how applicants apply texture by the specific methods specified in these claims. Again the Examiner has simply failed in the task of a fact finder to cite any prior art to teach the claimed invention. Because the Examiner has already admitted that Chen et al., '678 does not disclose pressing the layers together under increase pressure and temperature to bond them together to cure the thermosetting resin, the additional defects admitted as to the failure of Chen et al., '678 in not disclosing specific methods of applying texture as specified in dependent claims 2, 4-6, 11, 13 and 14, removes the Chen et al., '678 reference further from making obvious the claimed invention.

THE REJECTION OF CLAIMS 7-10

Initially, the Examiner concedes that Chen et al '678 does not disclose the decorative layer or the wear layer being paper, i.e. cellulose impregnated with resin". (It is presumed that Chen et al '678 also still fails to disclose pressing the layers together under increase pressure and temperature to bond them together and cure the thermosetting resin) as conceded with regards to the rejection of claims 1-6 and 11-16 (upon which dependent claims 7-10 are ultimately dependent). Therefore, even assuming *arguendo*, that Chen et al '009 disclose a flooring material having a decorative layer made of urea formaldehyde impregnated paper and the wear layer is made of the same thing, that proposed combination still does not establish a prima facie case obviousness for the claimed invention because the Examiner simply fails to address the limitation of the claims which the references concededly lack.

THE REJECTION OF CLAIM 13

Claim 13 stands rejected under 35 U.S.C. 103 (a) as being unpatentable over Chen et al. '678 as applied to claim 1 above and further in view of the "admitted prior art". It is still presumed that the Examiner is not withdrawing his admission that the Chen et al. '678 reference "does not disclose

pressing the layers together under increased pressure and temperature to bond them together in cure of the thermosetting resin" as specified in independent claim 1, upon which claim 13 is dependent.

Thus, by statute (35 U.S.C. 112, fourth paragraph) all the limitations of claim 1 also appear in claim 13.

The Examiner further concedes that Chen et al '678 "cited above does not disclose using a press foil to apply a design". However, claim 13 does not merely recite using a press foil to apply a design but rather specifically recites "a press foil provided with a microstructure is arranged on top of the wear layer during the pressing". Thus, the Examiner should have properly addressed his concession that Chen et al '678 cited above "does not disclose using a press foil provided with a microstructure arranged on top of the wear layer during the pressing.

Thus, the so called "admitted prior art" only states that it is known to use press foils (page 1, penultimate line). Thus, whether it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a press foil to apply texture to the wear layer, there is still no evidence that press foils with microstructures have been applied in the manner specified in the claims.

CONCLUSION

Thus, for all of the foregoing reasons, applicants respectfully submit that the Examiner has simply failed as a fact finder to even attempt to locate relevant prior art references teaching the limitations specified in the claims on appeal which the Examiner concedes are missing from the disclosure of the cited references. As no prima facie case can be established by these rejections, going forward to the Board of Appeals would be an undo delay to applicants because on their face, the rejections as so faulty because the Examiner concedes that so many parts of the claimed invention are missing from the cited references and cites no references teaching those missing features, the rejection, on its face, fails to establish a prima facie case of obviousness for the claimed invention.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith, or credit any overpayment, to our Deposit Account No. 14-1437, under Order No. 8.

Dated: November 4, 2009

Respectfully submitted,

By_____

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Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 8688.047.US0000

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

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Signature _____

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Application Number	Filed
10/580,255	June 7, 2006

First Named Inventor: Ake SJOBERG

Art Unit	Examiner
1791	MUSSER, BARBARA J

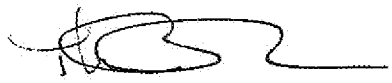
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 31,689
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____



Signature

Thomas P. Pavelko

Typed or printed name

202-659-0100

Telephone number

November 4, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of One (1) forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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